> would not affect the right of the applicant to eventually have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner, rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification....
>
> It is apparent that § 121 provides the Commissioner with the authority to promulgate rules designed to *restrict* an *application* to one of several claimed inventions when those inventions are found to be "independent and distinct." It does not, however, provide a basis for an examiner acting under the authority of the Commissioner to *reject* a particular *claim* on the same basis.

Id. at 331-332 (emphasis in the original). *See also In re Haas*, 179 U.S.P.Q. 623, 624, 625 (*In re Haas I*)(C.C.P.A. 1973) and *In re Haas*, 198 U.S.P.Q. 334-337 (*In re Hass II*)(C.C.P.A. 1978). *See also* M.P.E.P. § 803.02.

It has long been held that an Examiner may not reject a particular claim on the basis that it represents "independent and distinct" inventions. *See Weber*, *supra*. The courts have definitively ruled that the statute authorizing restriction practice, *i.e.*, 35 U.S.C. § 121, provides no legal authority to impose a restriction requirement on a single claim, even if the claim presents multiple independently patentable inventions. *See Weber*, *In re Haas I*, and *In re Haas II*, *supra*. In the case set forth above, the courts expressly ruled that there is no statutory basis for rejecting a claim for misjoinder, despite previous attempts by the U.S. Patent and Trademark Office to fashion such a rejection. As noted in *Weber*, "The discretionary power to limit one applicant to one invention is no excuse at all for refusing to examine a broad generic claim – no matter how broad, which means no matter how many independently patentable inventions may fall within it." *See Weber* at 34.

Applicants respectfully submit that the proper procedure for reducing the administrative burden on the PTO when examining a generic claim is Election of Species. According to this practice, Applicants elect a species upon which the generic claims read in order to facilitate examination of such claims. Where both generic and specific claims are presented in an application, election of species to facilitate the examination of the generic claims is proper. *See* M.P.E.P. § 808.01(a).

Accordingly, Applicants propose to elect a species encompassed by the generic claims to facilitate prosecution on the merits. Should the PTO conclude that an Election of Species is in fact proper, Applicants could, for example, elect the species of SEQ ID NO:1. Such an election of species would reduce the administrative burden on the PTO while preserving Applicants' right to claim their invention as they choose. Therefore, Applicants respectfully request that the outstanding Restriction Requirement be withdrawn.

Should the PTO maintain the Sequence Election Requirement Applicable to Groups I-III, Applicants further elect, provisionally and with traverse, the crystal of Claim 1 wherein the LuxS is *H. pylori* LuxS (SEQ ID NO:1).

CONCLUSION

Applicants submit that the claims are in condition for allowance. An early indication of the same and passage of Claims 1-42 to issuance is therefore kindly solicited.

Applicants believe no other fee is due in connection with this response. However, the Commissioner is authorized to charge all required fees, fees under 37 C.F.R. § 1.17 and all required extension of time fees, or credit any overpayment, to Pennie & Edmonds LLP U.S. Deposit Account No. 16-1150. (10342-012-999)

Respectfully submitted,

Date: August 13, 2003

42,983

Rahul Pathak (Reg. No.)
For: Laura A. Coruzzi (Reg. No. 30,742)
PENNIE & EDMONDS LLP
1155 Avenue of the Americas
New York, New York 10036-2711
(650) 493-4935